

### **REMARKS/ARGUMENTS**

With this Amendment, Applicant amends claims 1-6 and 9-15 and cancels claim 7 without prejudice or disclaimer. No new matter is added. Therefore, claims 1-6 and 9-15 are all the claims currently pending in the application. Based on the foregoing amendments and the following remarks, Applicant respectfully requests reconsideration of the application and allowance of the application.

#### **I. Rejection of Claims 1-7 & 9-17 Under 35 U.S.C. § 112, second paragraph**

Claims 1-7 and 9-17 stand rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. (See pg. 2 of the Office Action) In particular, the Examiner alleges that the recitation “‘expired data point’ is vague and indefinite.” (See *id.*)

Applicant herein amends claims 1-6 and 9-17 and submits that these self-explanatory claim amendments overcome the rejection. As such, Applicant respectfully requests the Examiner to reconsider and withdraw the 112, second paragraph rejection of claims 1-6 and 9-17. Since claim 7 is herein canceled without prejudice or disclaimer, Applicant submits that the § 112 rejection of claim 7 is moot.

#### **II. Rejection of Claims 1-7 & 9-17 Under 35 U.S.C. § 101**

Claims 1-7 and 9-17 stand rejected under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory subject matter. (See pg. 2 of the Office Action)

Regarding independent claim 1 and its dependent claims 2-6, 9 and 17 as well as independent claim 10 and its dependent claim 11 and independent claim 12 and its dependent claim 13, Applicant submits that these claims have been amended to recite an apparatus and indeed recite statutory subject matter. Support for these amendments may be found at least at lines 10-31 on page 17 and lines 1-24 on page 18 of the originally-filed specification. In view of the self-explanatory amendments to claims 1-6, 9, 10-13 and 17, Applicant respectfully requests that the § 101 rejection of claims of claims 1-6, 9, 10-13 and 17 be reconsidered and withdrawn.

Applicant again points out that since claim 7 is herein canceled without prejudice or disclaimer, the § 101 rejection of claim 7 is moot.

With respect to claims 14-16, Applicant notes that MPEP § 2106.01, I., which guides the Examiner in such matters, provides that “a *claimed computer-readable medium* encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program ... which permit the computer program’s functionality to be realized, and is ... *statutory*.” (emphasis added).<sup>1</sup> Claims 14-16 are herein amended to recite “[a] *computer program* product comprising at least one *computer-readable storage medium* having *computer-readable program code portions* stored therein ...” As such, claims 14-16 conform to the guidelines of the MPEP and as such, Applicant respectfully requests the Examiner to reconsider and withdraw the § 101 rejection of claims 14-16. Support for the amendments to claim 14-16 may be found at least at lines 10-31 on page 17 and lines 1-24 on page 18 of the originally-filed specification. Based on the self-explanatory amendments to claims 14-16, Applicant respectfully requests that the § 101 rejection of claims 14-16 be reconsidered and withdrawn.

### III. Rejection of Claims 1-7 & 9-17 Under 35 U.S.C. § 103(a)

Claims 1-7 and 9-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,784,635 to McCallum (“McCallum”), in further view of U.S. Publication No. 2004/0220836 to Doherty et al. (“Doherty”).

Claim 1, as herein amended, recites *inter alia*, “[a]n apparatus comprising a processor configured to: convert a data point from a first format into a uniform format, wherein said data point represents data from an insurance claim; ... and *identify* one or more *expired data points* of *said plurality of data points* in said memory and *creates at least one summary* associated with the *one or more expired data points*, wherein *each of the expired data points* are associated with

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<sup>1</sup> MPEP § 2106.01, I. also provides that “a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus *statutory*.” (emphasis added)

*a time period and wherein the summary comprises information associated with one or more insurance claims and the processor is configured to reduce the information in at least one of the insurance claims in response to a respective time period elapsing.*

Applicant submits that the combination of McCallum and Doherty do not teach or suggest all of the features of amended claim 1. In rejecting claim 1, the Examiner correctly concedes that McCallum does not teach or suggest all of the features of claim 1. However, the Examiner relies on Doherty to make up for the deficiencies of McCallum. (See pg. 4 of the Office Action) In particular, the Examiner concedes that “McCallum fails to teach a system ... that identifies one or more expired data points of a plurality of data points ... and creates at least one summary associated with the one or more expired data points.” (See *id.*) However, the Examiner relies on paragraphs [0050], [0055] and [0056] of Doherty to make up for the deficiencies of McCallum. (See *id.*) Applicant disagrees and submits that Doherty does not make up for what McCallum lacks. In contrast to claim 1, the cited portion and indeed all of Doherty, alone or in combination with McCallum, at best discloses that the Health Information Management environment (eHIM) “consolidates multiple disparate functions into a single integrated system providing access to information and work flow systems virtually and remotely and eliminates burdensome manual paper based processing” and describes that “an Electronic Healthcare Record” serves as “a basis for capturing, digitizing, storing, and/or managing information.” (Paragraphs [0050] and [0055] of Doherty)

Additionally, the cited portion and indeed all of Doherty, alone or in combination with McCallum, at best discloses that “[d]ata is consolidated into a single system rather than multiple systems.” (Paragraph [0056] of Doherty) However, nowhere in Doherty, alone or in combination with McCallum, is there any mention, teaching, suggestion or motivation relating to *identifying any expired data points of a plurality of data points stored in memory and creating at least one summary associated with the expired data points*, “wherein ... *the expired data points are associated with a time period and wherein the summary comprises information associated with one or more insurance claims and the processor is configured to reduce the information in at least one of the insurance claims in response to a respective time period elapsing,*” as required by claim 1. In contrast to claim 1, Doherty, alone or in combination with McCallum, is

altogether silent regarding any data point that is associated with a time period and reducing information of an insurance claim in response to a respective time period elapsing, as claimed.

For at least the foregoing reasons, the combination of McCallum and Doherty is deficient and does not teach or suggest all of the features of claim 1. Accordingly, Applicant respectfully requests that the § 103(a) rejection of claim 1 and its dependent claims 2-6, 9 and 17 be reconsidered and withdrawn. Since dependent claim 7 is herein canceled without prejudice or disclaimer, Applicant submits that the § 103(a) rejection of claim 7 is moot.

Since independent claims 10, 12, 14, 15 and 16 contain features that are analogous to, though not necessarily coextensive with the features of claim 1, Applicant submits that independent claims 10 and 12 and their respective dependent claims 11 and 13 as well as independent claims 14, 15 and 16 are patentable at least for reasons analogous to those submitted for claim 1.

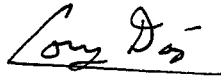
#### **IV. Conclusion**

In light of the remarks above, Applicant respectfully submits that the application is in condition for allowance and respectfully requests that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicant's undersigned attorney to resolve any remaining issues in order to expedite examination of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Appl. No.: 10/798,999  
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Respectfully submitted,

A handwritten signature in black ink, appearing to read "Cory Davis", with a horizontal line drawn underneath the signature.

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